



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,080	12/20/2001	John Laurence Minck JR.	267/166	9793

7590 08/23/2005

DAVID T BURSE
BINGHAM MCCUTCHEN LLP
THREE EMBARCADERO CENTER, SUITE 1800
SAN FRANCISCO, CA 94111-4067

EXAMINER

BAXTER, JESSICA R

ART UNIT PAPER NUMBER

3731

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/027,080

Applicant(s)

MINCK ET AL.

Examiner

Jessica R. Baxter

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4,6-13,29-36 and 40-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-4,6-13,29-36 and 40-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 3,4, 9, 29-37 and 40-48 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,980,554 to Lenker et al.

Lenker discloses a vaso-occlusive device comprising a member having a first end, a second end, and a length extending therebetween the first and second ends (FIG. 14), the member having a first curvilinear portion and a linear portion located next to the curvilinear portion, and a second curvilinear portion, the linear portion being relatively straight, wherein the first curvilinear portion resembles a parabola (FIG. 14), with an end segment of the first curvilinear portion connecting to and forming an angle with the linear portion when the member is in a relaxed configuration; wherein the first curvilinear portion (19) and the linear portion lie approximately within a plane when the member is in the relaxed configuration (FIG. 14).

Art Unit: 3731

3. Claims 2-4, 8, 9, 13, 29-31, 33-36, 40-44, and 46-48 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,136,015 to Kurz et al.

Kurz discloses a vaso-occlusive device comprising a member having a first end, a second end, and a length extending between the first and the second ends, the member having a first curvilinear portion (2) and a linear portion (1) located next to the curvilinear portion, the linear portion being relatively straight, wherein the first curvilinear portion resembles a parabola (FIGS. 1-5), with an end segment of the first curvilinear portion connecting to, and forming an angle with, the linear portion when the member is in a relaxed configuration; wherein the first curvilinear portion and the linear portion lie approximately within a plane when the member is in the relaxed configuration; wherein the member comprises a coil (coil 1); wherein the serpentine shape is located adjacent one of the ends of the member (FIGS. 1-5), wherein the member is stretch resistant (Column 9 lines 6-13).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lenker et al. '554 in view of U.S. Patent No. 5,690,666 to Berenstein et al.

Lenker discloses the claimed invention except for one of the ends of the member being electrolytically detachable from a delivery device. Berenstein teaches that an

electrolytic connection between a vaso-occlusive member and a delivery device is advantageous since it forms a thrombus as the device is detached from the delivery device (Column 2 lines 36-54). It would have been obvious to one having ordinary skill in the art at the time the invention was made to detach the vaso-occlusive member of Lenker electrolytically since it helps form a thrombus.

6. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lenker et al '554.

Lenker discloses the claimed invention except for the particular dimensions of the member's length and amplitude. It would have been an obvious matter of design choice to change the member's length and amplitude, since such a modification would have involved a mere change in the size of a component and there is no stated reason and solves no particular problem for the particular length and amplitude claimed (see paragraph 17). A change in size is generally recognized as being within the level of ordinary skill in the art. The length and amplitude of the Lenker device can be adapted for different sizes of aneurysms and would work equally well when made larger or smaller to suit the aneurysm.

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lenker et al. '554 in view of U.S. Patent No. 6,136,015 to Kurz et al.

Lenker discloses the claimed invention except for the distal end of the member having a J-shaped tip. Kurz teaches that the J-shaped tip is provided on the distal end of the device to prevent the device from puncturing the tissue, to prevent the coil from migrating into the artery, and to prevent coil realignment (Column 3 lines 21-58). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide

Art Unit: 3731

the device of Lenker with a J-shaped tip in order to prevent the device from puncturing the tissue, to prevent the coil from migrating into the artery, and to prevent coil realignment.

8. Claims 11, 12, 50 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lenker et al. '554 in view of U.S. Patent No. 5,382,259 to Phelps et al.

Lenker discloses the claimed invention except for a polymeric fiber wrapped around the surface of the member. Phelps teaches that a polymeric fiber is wrapped around the member to enhance the ability of the coil to fill the space within the vasculature and to increase embolic and tissue growth around the member (Column 1 lines 40-58). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Lenker with a polymeric fiber wrapped around its member in order to enhance the ability of the member to fill the space and to increase embolic and tissue growth.

Response to Arguments

9. Applicant's arguments filed 10 June 2005 have been fully considered but they are not persuasive.

10. The added limitation does not overcome the Lenker et al. '554 reference because the newly added limitation does not require the entire device to lie within a single plane. The embodiment of Figure 14, clearly shows a device that has a curvilinear portion (19) and a linear portion (the portion that lies against the vessel wall) that lies within a single plane.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica R. Baxter whose telephone number is 571-272-4691. The examiner can normally be reached on M-F 8:30AM - 5:00PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit 3731

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jessica R Baxter
Examiner
Art Unit 3731


jrb


EDUARDO C. ROBERT
PRIMARY EXAMINER